

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

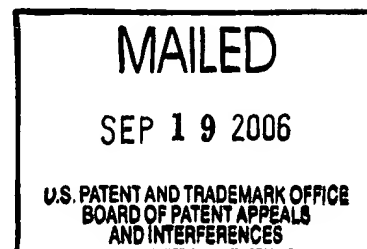
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOUIS BOUCHARD and DUSTIN M. DONALDSON

Appeal No. 2006-2097
Application No. 09/697,113

ON BRIEF



Before HAIRSTON, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-20, and 22-27, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The invention relates to using an instant messaging service to notify a user of a message that has been received for the user. Claim 1 is reproduced below.

1. A method of providing message notification for a user comprising the steps of:
 - a. coupling a message notification application to a server, wherein the server stores messages for the user;
 - b. registering the message notification application to at least one instant messaging service;
 - c. accessing one of the at least one instant messaging service by the user;
 - d. signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing; and
 - e. sending an instant message notification from the message notification application via the one instant messaging service to the user when a message arrives on the server for the user.

The examiner relies on the following references:

Goldfinger et al. (Goldfinger)	US 6,449,344 B1	Sep. 10, 2002 (filed Jan. 27, 1997)
Cloutier et al. (Cloutier)	US 6,535,586 B1	Mar. 18, 2003 (filed Dec. 30, 1998)

Claims 1, 3-20, and 22-27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cloutier and Goldfinger.

We refer to the Final Rejection (mailed Apr. 15, 2004) and the Examiner's Answer (mailed Dec. 29, 2005) for a statement of the examiner's position and to the Brief (filed Sep. 8, 2005) and the Reply Brief (filed Feb. 21, 2006) for appellants' position with respect to the claims which stand rejected.

OPINION

Cloutier describes a system for notification and retrieval of electronically stored messages. The preferred embodiment relates to e-mail messages received by an e-mail server and notifying the user when an e-mail is received by means of a messaging system server (col. 3, ll. 1-60; Fig. 1). The devices specifically described for the notification by the messaging system server are wireless devices, personal computers connected to the Internet, and telephones. Col. 3, l. 61 - col. 4, l. 25. However, the reference suggests several more alternatives for notification (e.g., col. 2, ll. 30-41).

The rejection of representative claim 1 (Answer at 4-6) acknowledges that Cloutier does not disclose the specifics relating to the instant messaging service. Goldfinger is relied upon for, inter alia, the teaching of adding the user to a buddy list for the message notification application and the teaching of "sending an instant message via the one instant message service to the user when a message arrives on the server for the user (col. 6, lines 35-50, Goldfinger teaches a server sending a message to a user when it arrives from another user)." (Answer at 5.)

Instant claim 1 requires signing the user onto the message notification application by adding the user to a buddy list to associate the user with the instant messaging service. The claim further requires sending an instant message notification via the instant messaging service to the user when a message arrives on the server for the user.

Reference is now made to FIG. 2 which shows a user 34 establishing a connection to communications network 14 preferably in the same manner as described for user 18 in FIG. 1. Once user 34 is connected, information management apparatus 28 checks the list of sought users to determine if user 34 is sought by user 18. If so, information management apparatus 28 then checks the list of connected users to determine if user 18 is still connected. If user 18 is still connected, information management apparatus 28 causes annunciator 24 to transmit an annunciation to user 18, wherein the annunciation typically includes the unique identification code for sought user 34, the current network address for sought user 34, and preferably other information provided by user 18. Information management apparatus 28 preferably also checks the list of sought users to determine if user 18 is sought by user 34 and, if so, causes annunciator 24 to transmit an annunciation to user 34 as described above.

Goldfinger col. 6, ll. 35-50.

Goldfinger fails to support the examiner's finding that the reference teaches a server sending a message to a user when it arrives from another user. The reference thus cannot teach sending an instant message via an instant messaging service to a user when a message arrives on the server for the user. As the above-quoted portion of Goldfinger relates, server 20 sends an annunciation to a user if the user is listed as a sought user by another user, in the event that both users are connected to the network. The annunciation includes the current network address for the sought user such that

the two users may make a point-to-point connection (Fig. 3) that is independent of server 20 after reception of the necessary information. Col. 6, l. 66 - col. 7, l. 6.

If Goldfinger describes any sort of "instant messaging service," it is the point-to-point connection between users on the network.¹ As such, the reference does not disclose any kind of instant messaging service to which a message notification application might be registered, and might use to send notification messages to a user, in accordance with the requirements of claim 1.

We are thus in ultimate agreement with appellants to the extent that the proposed combination of Cloutier and Goldfinger so as to meet the requirements of instant claim 1 could only result from an improper hindsight reconstruction of the invention. Since each of the remainder of the independent claims (8, 14, 20, and 27) contains limitations similar to those in claim 1 for which the rejection is deficient, we do not sustain the § 103 rejection of claims 1, 3-20, and 22-27.

¹ Note, for comparison, the prior art instant messaging services described in the background (at 1-2) and description of the invention (at 3) of the instant specification.

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